

REMARKS

Please reconsider the application in view of the above amendments and the following remarks. Applicants thank the Examiner for carefully considering this application.

Disposition of Claims

Claims 1-38 are pending in this application. Claims 1, 10, 15, 19, 20, 32 and 35 are independent. The remaining claims depend, directly or indirectly, from Claims 1, 10, 15, 19, 20, 32 and 35. While the Applicants believe that the claims as originally filed are patentable over the art of record, Applicants have amended Claims 7, 11, 17, 22, 32, 35 and 37 herein to eliminate clerical errors and/or to capture additional subject matter.

Drawings

The Office Action indicates that Figures 1-8 should be designated as Prior Art. Applicant respectfully traverses the objection in that the material provided in Figures 1-8 is not properly classified as prior art. Figures 1-8 depict experimental data and related information that does not qualify as prior art.

Specification

The Office Action indicates that the term MONEL is a trademark and should be capitalized and accompanied by the generic terminology. Applicants have amended the specification to indicate that MONEL® is a registered trademark. Applicants have also amended the specification to indicate that TEFLON® and INCOLOY® are registered trademarks. No new matter has been added by way of these amendments to the drawings.

Claim Objections

Claims 7, 11, 17, 22 and 37 were objected to because they contain the trademark MONEL. Applicants have amended the claims herein to remove the term MONEL as requested. No new matter has been added by way of these amendments.

Rejection(s) under 35 U.S.C § 112, first paragraph

Claims 32-38 were rejected under 35 U.S.C. § 112, first paragraph, "as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention," namely the phrases "hydraulic mechanism" or "hydraulic assembly." Applicants have amended claims 32 and 35 to eliminate these phrases and clarify the claimed invention. No new matter is added by way of this amendment. Applicants submit that these amendments obviate the rejection of claims 32-38.

Rejection(s) under 35 U.S.C § 103

Claims 1-31, 35-38 are rejected under 35 U.S.C. § 103 as being obvious over Abercrombie (US 4,605,065) in view of Lively et al (and various additional references with respect to some claims).¹ Applicant respectfully traverses the rejection. The Examiner has failed to establish a prima facie case of obviousness based on the cited references.

Each of Applicant's claims recite (in various ways) a downhole tool comprising at least one sample of material that is optically reactive to the presence of hydrogen sulfide, and exposure of the material to fluid from a reservoir.

¹ In a telephone call with the Examiner on or about August 14, 2003, the Examiner verified that Paragraphs 7-13 of the Office Action incorrectly cite to Carrier et al. and that such reference should be replaced by Lively et al.

In contrast, Abercrombie describes techniques for monitoring the corrosion characteristics of tubing fluid flowing through tubing. See *Abercrombie Col. 1, lines 7-12*. As shown in Figure 4 reproduced below, the coupon (59) of Abercrombie is positioned within a slot (31) between the main bore (25) and the side pocket (27) of the downhole tool: (31) between the main bore (25) and the side pocket (27) of the downhole tool:

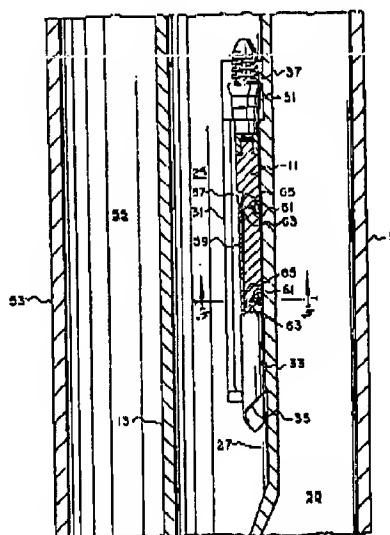


Fig. 4

Abercrombie does not contemplate exposing a material that is optically reactive to the presence of hydrogen sulfide to formation fluid produced from the reservoir as recited in Applicant's claims.

The deficiencies of Abercrombie are not met by Lively or any other reference of record. Lively teaches the use of coupons placed in the sidepocket of the mandrel of a tubing string. See *Lively Abstract*. Like Abercrombie, Lively focuses on tubing (and wellbore) fluids, but fails to teach or even suggest exposing a material that is optically reactive to the presence of hydrogen sulfide to formation fluid produced from the reservoir as recited in Applicant's claims.

Claims 32-34 were rejected under 35 U.S.C. § 103 as being obvious over Abercrombie in view of Williams and Waterman. Applicants respectfully traverse the rejection. Again, the Examiner has failed to establish a prima facie case of obviousness.

Applicant's claims 32-34 each recite coupons that are optically reactive to the presence of hydrogen sulfide, and exposure of the material to fluid from a reservoir. As discussed above, Abercrombie fails to contemplate exposing a material that is optically reactive to the presence of hydrogen sulfide to formation fluid produced from the reservoir as recited in Applicant's claims. Moreover, the cited references fail to disclose a probe capable of flowing formation fluid into the downhole tool as recited in Applicant's claims.

The deficiencies of Abercrombie are not met by Williams and/or Waterman. Williams specifically teaches away from the use of side pocket coupon holders as described by Abercrombie and, therefore, teaches away from the combination of Williams and Abercrombie. *See Williams Col. 1, lines 23-47.* Waterman teaches the use of electrical resistance measuring elements for monitoring corrosion levels. Like Abercrombie, Waterman monitors fluid as it flows through tubing, and fails to contemplate exposing a material that is optically reactive to the presence of hydrogen sulfide to formation fluid produced from the reservoir as recited in Applicant's claims.

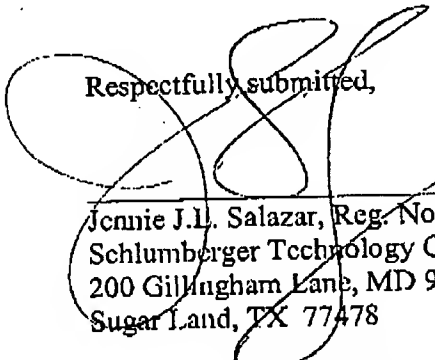
For at least these reasons, Applicants respectfully submit that the art of record fails to anticipate or render obvious any of Applicants' Claims. Moreover, Applicants respectfully submit that none of the art of record teaches Applicants' claimed invention. Applicants, therefore, request withdrawal of the rejection Applicants' Claims under 35 U.S.C. § 103 based on the cited art and allow Applicants' claims.

U.S. Patent Application No.: 09/904,199
Attorney Docket No.: 20.2756

Applicant believes this reply to be fully responsive to all outstanding issues and place this application in condition for allowance. If this belief is incorrect, or other issues arise, do not hesitate to contact the undersigned at the telephone number listed below. Applicant believes that a one-month extension of time is due for this response dated September 15, 2003 (Sept. 14 is a Sunday, so the 2 month deadline rolls to Sept. 15, 2003). The Commissioner is authorized to charge Applicant's deposit account with the two-month extension fee of \$410. Please apply this and any charges not covered, or any credits, to Deposit Account 19-0610 (Reference Number 20.2756).

Date: 9/15/03

Respectfully submitted,


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